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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,472	02/18/2004	Jonathan Dale	073338.0135 (02-53312 FLA	4871
5073	7590	04/24/2008	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			McCORMICK, GABRIELLE A	
			ART UNIT	PAPER NUMBER
			3629	
			NOTIFICATION DATE	DELIVERY MODE
			04/24/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/782,472

**Applicant(s)**

DALE, JONATHAN

**Examiner**

GABRIELLE MCCORMICK

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 1/16/2007 & 3/28/2007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the application filed on February 18, 2004.
2. Claims 1-25 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The Information Disclosure Statements filed January 16, 2007 and March 28, 2007 have been considered. Initialed copies of the Form 1449 are enclosed herewith. The Examiner notes that several of the 30 pieces of Non-Patent Literature (NPL) are lengthy and, in total, correspond to approximately 800 pages. The Examiner has made a  *cursory review*  of this collection and requests that the Applicant cite passages relevant to the examination of the filed claims.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 1, 9, 17 and 25 require the establishment of an "organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements" and the determination of whether a service provider is satisfactory based on service descriptors satisfying "a portion of the business function requirements" followed by ranking of the providers. It is unclear in the determination of

satisfaction of providers whether a service provider is compared to all the business function requirements that would encompass all business function descriptions in the organizational database and thus produce a ranking based on which provider could meet the needs of the highest number of business function descriptions (e.g., the database contains various entities (companies or divisions within a company) and providers are ranked based on meeting the needs of the highest number of entities) or alternately, are the providers ranked on meeting the highest number of business function requirements of a single entity? Thus, the scope of the claims cannot be ascertained.

7. Claims 2, 10 and 18 contain the conditional phrase, "if the service provider is satisfactory" without a recitation for the alternative. It is therefore unclear as to whether the claims cite any positive limitations when the "if" statement is not fulfilled.
8. Claims 4, 12 and 20: It is unclear whether the "at least one negotiation threshold" corresponds to the modified at least one deal parameter or variable service descriptors such that a comparison of the variable service descriptors against the negation threshold can be achieved after the iterative modification of the deal parameter. Further, as the claims recite the step of "iteratively accessing...to negotiate..." it is unclear at what point the negotiation would end, if at all, therefore the scope of the claims cannot be ascertained.
9. Claims 6, 14 and 20 recite a determination of whether "one of the satisfactory service providers ranks higher than the current service provider" without an initial ranking of the current service providers, and thus are unclear because they appear to omit an essential step.
10. Claim 9 discloses a system with "an organizational agent"; however, it is unclear whether the organizational agent is operable to provide the communication, access, determination and ranking steps associated with the service providers. The system components or structure is not claimed such that one understands the structure required to carry out these steps.

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 9-24 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.
13. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof". Applicant's claims 9-16 are directed to a system, however, recite as part of the system "a plurality of service providers". As service providers encompass human beings, they are not a statutory class of subject matter and therefore are not patent eligible subject matter. "If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter." (MPEP; 2105)
14. Claims 17-24 are directed to "logic encoded in a computer readable medium". A "computer readable medium is not given a definition in the specification or the claims and therefore could reasonably encompass a carrier wave signal, which is non-statutory subject matter. Proper claims directed to computer-readable media must be limited to tangible storage media such as a hard disk or CD-ROM.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. **Claims 1-7, 9-15, 17-23 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha").
17. **Claims 1, 9, 17 and 25:** Das discloses
- *a plurality of business function requirements;* (P[0047]: "short or long term strategic purchasing policy rules")
  - *accessing a service registry of a plurality of service providers;* (P[0065])
  - *for each of the identified service providers:*
  - *communicating with the service provider to determine feature interfaces for interacting with the service provider;* (P[0050]: "services" are identified, therefore, service providers comprise the vendors of P[0066])
  - *accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider;* (P[0068] negotiations are conducted using the internal rules and parameters (see P[0047] for examples of rules and P[0048] for example of parameters). P[0050]: parameters are used to negotiate the purchase from sellers, therefore, negotiation involves determining descriptors provided by the provider. P[0052]: vendors are compared based on price and quality, thus, price and quality are disclosed as descriptors.)
  - *determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements;* (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes and rank ordered lists of preferred vendors (i.e., satisfactory) and P[0052]).
  - *ranking each of the service providers based on the service descriptors from each of the satisfactory service providers.* (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes and rank ordered lists of preferred vendors).
18. Das does not explicitly disclose *establishing an organizational database maintaining at least one business function description comprising a business function indicator; using the business*

*function indicator to identify a network address for each service provider each having a service indicator matching the business function indicator; or ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.*

19. Vashistha, however, discloses a registration module for buyers and providers that includes a buyer database. Buyer and supplier profiles are entered such that the outsourcing system can suitably match buyers and providers, therefore, it is obvious that a business function indicator is disclosed that enables identification of the provider. (P[0036]); the matching module uses data and criteria from buyers to match to data captured from providers so to identify only those providers meeting a minimum level of matching. (P[0038]: this discloses the functionality of determining a satisfactory level based on business function requirements where the provider is identified by the business function description. A service provider's network address is identified such that notification of qualified providers can be made via e-mail (P[0038]). Vashistha further discloses ranking the bids received from the selected providers based on "buyer specified criteria" (i.e., "satisfactory" providers) prior to final selection. (P[0041]).
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an organizational database using business function indicators to identify a network address for each provider and ranking based on service descriptors, as disclosed by Vashistha in the system disclosed by Das, for the motivation of providing a method that "enables buyers, i.e., companies that need IT projects and/or services implemented and completed, to obtain end-to-end knowledge and support to initiate, decide and implement IT projects and services with providers..." (Vashistha; P[0029]). Das discloses the system and methodology for automatically making operational purchasing decisions in a data network using purchasing rules that evaluate possible vendors to identify a set of vendors from which the product or service may be obtained, with a final selection for purchase from one or more vendors using rules, information about the vendors and the results of negotiations. (Das; P[0013]). Therefore, both Vashistha and Das aim to accomplish the objective of matching buyers and

providers using rule based decision making systems and methodologies, thus it is obvious to expand Das to include the features of Vashistha.

21. **Claims 2, 3, 5, 7, 10, 11, 13, 15, 18, 19, 21 and 23:** Das discloses parameters for negotiating the purchases from sellers using variable service descriptors, including price, quantity, allowable substitutions, order size and delivery times (P[0050]). Following the negotiations, controller 410 selects one or more of the potential vendors (P[0080]) and provides notification/authorization by transmitting purchase orders to the selected vendors. (P[0073]). Das does not disclose ranking based on the negotiations.
22. Vashistha, however, discloses ranking bids (P[0066]) following a discussion and bidding module which provides a mechanism for facilitating the collaboration between buyers and providers to obtain an improved understanding of the RFP. (P[0064]. Vashistha also discloses providing a qualified list of providers following scoring and ranking, thus providing a notification identifying the highest ranking provider. (P[0063]).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included ranking prior to final selection, as disclosed by Vashistha, in the system of Das for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.
24. **Claims 4, 12 and 20:** Das discloses a plurality of deal parameters and a negotiation threshold (i.e., "maximum acceptable price") (P[0047-0048]) and performing a negotiation via a "back-and-forth sequence of offers and counteroffers" where each counteroffer is compared to rules to determine acceptability. (P[0068]).
25. **Claims 6, 14 and 22:** Das discloses retrieving a list of known vendors and additionally querying a directory to find new vendors to add to the list (P[0065]). Vendors are then negotiated with



- (P[0068]) until a selection is made and a purchase order transmitted (P[0073]). Das does not disclose a highest ranking between current and satisfactory service providers.
26. Vashistha, however, discloses matching buyers to both providers the buyer currently uses and with a global network of providers where both buyers and providers are notified. (P[0038]). Vashistha further discloses providers are scored and ranked and the results provided in a qualified list of providers. (P[0063]). It is inherent in ranking that a highest ranking provider is identified, and therefore a notification of such is generated with the qualified list in P[0063].
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a highest ranking, as disclosed by Vashistha, in the system of Das for the motivation of for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.
28. **Claims 8, 16 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha") in further view of Chun et al. (US Pub. No. 2002/0184527, hereafter referred to as "Chun").
29. **Claims 8, 16 and 24:** Das/Vashistha discloses the limitations of claims 7, 15 and 23. Das discloses evaluating vendors to identify a set of vendors from which a service can be obtained. (Abstract). Das does not disclose payroll management, employee, payment or banking information.
30. Chun, however, discloses that businesses outsource payroll management (P[0004]) that includes the exchange of data relating to human resources and payroll. (P[0025]). Data and information relating to employees, salaries (i.e., payment) and banking are inherently comprised in the data disclosed.

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31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included payroll management and data, as disclosed by Chun, in the system of Das for the motivation of providing an example of a service providing vendor.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629